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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,761	10/31/2001	Thomas C. Amon	EVU-02-PUSA	5829
23410	7590	05/05/2005	EXAMINER	
COHEN SAKAGUCHI & ENGLISH LLP 2040 MAIN STREET, 9TH FLOOR IRVINE, CA 92614			EDELMAN, BRADLEY E	
			ART UNIT	PAPER NUMBER

2153

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,761

Applicant(s)

AMON ET AL.

Examiner

Bradley Edelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
____ Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to Applicant's remarks and the additional Affidavit filed on December 13, 2004. Claims 1-11 are presented for examination. This Office action is non-final, due to the new grounds for rejection. Note that this application is a continuation of application no. 08/912,991, which has been abandoned.

Response to Amendment

1. The Affidavits and arguments filed under 37 CFR 1.131 on December 13, 2004 have been considered and are effective to establish a reduction to practice date of September 5, 1996, but only for claims 1-6. The affidavits do not describe that Applicant reduced to practice the inventions described in claims 7-11, because they do not describe anything related to "the provider selected information causing the client program to transmit a second request" claimed in claims 7-9, and they do not describe the HTTP GET and POST details of claims 10-11. Therefore, the affidavit overcomes the Shi reference (U.S. Patent No. 5,875,296, filed January 28, 1997) for claims 1-6.

Regarding the affidavit as it relates to claims 1-6, Examiner agrees that the description of the invention in the affidavit as filed on December 13, 2004 is sufficient to show that Applicant reduced to practice the claimed invention for its intended purpose. Note that although the claims require transmitting information over a computer network, Examiner agrees with Applicant's argument that the demonstration described in the affidavit showed that the invention was suitable for intended its purpose. Examiner therefore agrees that adapting the HTML and Java for use over a computer network via

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a browser would have been a simple problem for any developer of HTML code or Java or browser programs.

In response to Applicant's affidavit, Examiner has found new art that reads on the claims, as described in the claim rejections below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by

Elgamel et al. (U.S. Patent No. 5,657,390, hereinafter "Elgamel").

In considering claim 1, Elgamel discloses a method of delivering information across a computer network, comprising the steps of:

Receiving a request from a client program for user-selected information (col. 9, lines 33-37, wherein the user clicks on a hyperlink); and

Transmitting provider-selected information ("encryption/decryption information") in response to the request if no qualifying provider-selected message has been previously transmitted to the client program (col. 9, lines 37-41, "before the transfer can occur, however, the handshake protocol is negotiated, and encryption/decryption is

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developed as described above,” wherein the encryption/decryption information contains provider selected session information as described in cols. 7-8, and wherein the provider selected encryption/decryption information is only transmitted if had not previously been transmitted within a certain time period, col. 9, lines 46-55).

In considering claim 2, claim 2 presents an apparatus for performing the same method as described in claim 1, wherein a server performs the receiving and transmitting steps. Elgamel discloses this server (“server”), and thus, claim 2 is rejected for the same reasons as claim 1.

In considering claim 3, Elgamel discloses a method of delivering information across a computer network, comprising the steps of:

Receiving a request from a client program for user-selected information (col. 9, lines 33-37, wherein the user clicks on a hyperlink); and

Transmitting provider-selected information in response to the request if no qualifying provider-selected message has been transmitted to the client program within at least one provider-selected interval (col. 9, lines 37-41, “before the transfer can occur, however, the handshake protocol is negotiated, and encryption/decryption is developed as described above,” wherein the encryption/decryption information contains provider selected session information as described in cols. 7-8, and wherein the provider selected encryption/decryption information is only transmitted if had not previously been transmitted within a certain time period, col. 9, lines 46-55).

In considering claim 4, claim 4 presents an apparatus for performing the same method as described in claim 3, wherein a server performs the receiving and transmitting steps. Elgamel discloses this server ("server"), and thus, claim 4 is rejected for the same reasons as claim 3.

In considering claim 5, Elgamel further discloses that the request from the client program is by means of the HTTP ("HTTP," col. 12, lines 6-7).

In considering claim 6, Elgamel further discloses transmitting the user-selected information if a qualifying provider-selected message has been previously transmitted to the client program (col. 9, lines 32-57, wherein if the encryption/decryption information was previously transmitted, the user-selected information is sent to the client).

3. Claims 7-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Shi et al. (U.S. Patent No. 5,875,296, hereinafter "Shi").

In considering claim 7, Shi discloses a method of delivering information across a computer network, comprising the steps of:

Receiving a request from a client program for user-selected information (col. 8, lines 16-18, wherein a server receives an HTTP request from a client browser); and

Transmitting provider-selected information ("login HTML form") in response to the request if no qualifying provider-selected message ("cookie," col. 6, lines 54-55) has

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been previously transmitted to the client program (col. 8, lines 26-33, wherein if no "cookie" has been transmitted from the provider to the client, then the provider transmits provider-selected login HTML form to the client);

The provider-selected information causing the client program to transmit a second request for user-selected information (col. 8, line 32 – col. 9, line 7, wherein the transmission of the login form to the client causes the client browser to later submit the filled in form, which, after authentication is complete, serves as the second request for the data).

In considering claim 8, claim 8 presents an apparatus for performing the same method as described in claim 7, wherein a server performs the receiving and transmitting steps. Shi discloses this server ("server"), and thus, claim 8 is rejected for the same reasons as claim 7.

In considering claim 9, Shi further discloses transmitting the requested user-selected information in response to the second request for user-selected information (col. 9, lines 3-8).

In considering claim 10, Shi discloses a method for delivering information across a computer network comprising the steps of:

Receiving an HTTP GET request from a client program for user-selected information (col. 8, lines 16-17);

Transmitting from a server a provider-selected information ("login HTML form") in response to the HTTP GET request (col. 8, lines 32-33);

The provider-selected message causing the client program to transmit an HTTP POST request (i.e. the form on the browser is filled out and transmitted back to the server); and

Transmitting the user-selected information in response to the HTTP POST request (col. 8, line 34 – col. 9, line 8, wherein the information is sent to the client after the authentication procedure is complete).

In considering claim 11, Shi further discloses that the HTTP POST request includes a referrer header containing a URL for the server (col. 8, lines 33-46, wherein the POST request is sent to the server, and therefore contains its URL).

4. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Levergood et al. (U.S. Patent No. 5,708,780, hereinafter "Levergood").

In considering claims 1-6, Levergood includes similar features as Elgamel, and discloses the features of claims 1-6 in col. 3, lines 10-55. See also, cols. 5-7, which give a more detailed description.

In considering claim 7, Levergood discloses a method of delivering information across a computer network, comprising the steps of:

Receiving a request from a client program for user-selected information (col. 3, line 21, "client request"); and

Transmitting provider-selected information in response to the request (col. 3, lines 39-41 ("authentication server then forwards a new request consisting of the original URL appended by the SID to the client") if no qualifying provider-selected message has been previously transmitted to the client program (col. 3, lines 22-38, wherein if no SID has been previously given to the client, a new SID is issued and transmitted);

The provider-selected information causing the client program to transmit a second request for user-selected information (col. 3, lines 41-42, "the modified request formed by a new URL is automatically forwarded by the client browser to the content server").

In considering claim 8, claim 8 presents an apparatus for performing the same method as described in claim 7, wherein a server performs the receiving and transmitting steps. Levergood discloses this server ("server"), and thus, claim 8 is rejected for the same reasons as claim 7.

In considering claim 9, Levergood further discloses transmitting the requested user-selected information in response to the second request for user-selected information (col. 3, lines 41-42, wherein the user-selected information is necessarily transmitted).

In considering claim 10, Levergood discloses a method for delivering information across a computer network comprising the steps of:

Receiving an HTTP GET request from a client program for user-selected information (col. 6, lines 34-35, "GET request");

Transmitting from a server a provider-selected information in response to the HTTP GET request (col. 7, lines 4-6, "form page");

The provider-selected message causing the client program to transmit an HTTP POST request (col. 7, lines 6-11, "POST message", wherein the form on the browser is filled out and transmitted back to the server); and

Transmitting the user-selected information in response to the HTTP POST request (col. 7, lines 15-20, describing that in response to the HTTP POST, the client requests the information from the server, which information is then necessarily transmitted to the client).

In considering claim 11, Levergood further discloses that the HTTP POST request includes a referrer header containing a URL for the server (col. 7, lines 5-9, wherein the POST request is sent to the server, and therefore contains its URL).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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For instance, Dedrick (U.S. Patent No. 5,724,521) anticipates at least claim 1 (see col. 10, lines 45-63).

Note also that a simple client-side caching system, such as disclosed in Bittinger et al. (U.S. Patent No. 5,878,213) also anticipates at least claim 1 (see col. 8, lines 24-67).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 571-272-3953. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached at 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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BE
April 27, 2005